

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 198821-368917	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/619,555	Filed JULY 16, 2003
First Named Inventor ZEENAT JETHA		Examiner SAMIR TERMANINI	
Art Unit 2178		Examiner SAMIR TERMANINI	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 54,883 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>			
Signature JOSEPH CONNEELY		Typed or printed name 416-601-8179 Telephone number DECEMBER 10, 2007 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of 1 forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Application. No. : 10/619,555
Title : A GRAPHICAL USER INTERFACE HAVING AN ATTACHED
TOOLBAR FOR DRAG AND DROP EDITING IN
DETAIL-IN-CONTEXT PRESENTATIONS
Applicant : Zeenat Jetha, et al.
Filed : July 16, 2003
Confirmation No. : 5946
Art Unit : 2178
Examiner : Samir Termanini
Docket No. : 198821-368917
Customer No. : 27,155

Commissioner of Patents
P.O. Box 1450
Alexandria, V.A. 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This is in response to the Examiner's Office Action mailed September 25, 2007 (the "Office Action").

Please note that a Notice of Appeal and the appropriate fee have been filed with this Request.

Please note that the present application is not under final rejection. However, the claims of this application have been rejected twice in which case the Applicant believes that a Pre-Appeal Brief Request For Review may be properly filed.

The following are the errors in the Examiner's rejections and/or the Examiner's omissions of one or more essential elements needed for a prima facie rejection for which the Applicant respectfully requests review:

First: In the "Response to Arguments" section on page 16 of the Office Action, the Examiner provides reasons for the rejection of the arguments the Applicant presented in its Amendment/Reply of July 16, 2007 as follows (underlining added):

"In response to the applicant's arguments against Dursteler and Nelson et al., individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. More specifically, Nelson et al., was the reference that taught, the direct manipulation features that applicant is now arguing Dursteler lacks. This holds true for the, first through fourth, points of applicants argument."

The Applicant respectfully submits that this is not correct. If a claim includes an element "A" and an element "B" and if the Examiner argues that prior art item "1" teaches element "A" and that prior art item "2" teaches element "B", then the Examiner's obviousness argument may be traversed by showing that prior art item "1" does not teach element "A". This is what the Applicant did in its Amendment/Reply of July 16, 2007.

Second: On pages 4-5 of the Office Action the Examiner has rejected Claim 1 under 35 U.S.C. 103(a) as being unpatentable over "The Digital Magazine of InfoVis.net: Focus + Content" by Juan C. Dursteler ("Dursteler") in view of United States Patent Application Publication No. 2003/0179237 by Nelson et al. ("Nelson"), stating (underlining added):

"As to independent claim 1, Dursteler describe(s): distorting the original image to produce a distorted region for the object being positioned at an initial position within the original image ('...distortion of the periphery...', p. 1), the distorted region including magnification of at least a portion of the object ('...of the zone of constant magnification...', p. 1); receiving a signal for dragging the object with the distorted region from the initial position ('...placing a lens...', p.1), to a desired position within the original image (see the 'Move Lens' mouse signal indicator in bottom left-hand side figure on p.1); and, receiving a signal for dropping the object at the desired position (see the 'Place Lens' mouse signal indicator in bottom left-

hand side figure on p. 1), whereby the distorted region with the magnification facilitates accurate positioning of the object at the desired position ('...so that we have higher accuracy and control in the center of the lens...' p. 1)."

The Examiner's above quoted arguments with respect to Claim 1 do not refer to the present wording of Claim 1. Rather, the Examiner's arguments refer to the previous wording of Claim 1. As such, the Applicant respectfully submits that the Examiner has not established a prima facie case of obviousness against Claim 1 under 35 U.S.C. 103(a).

Third: With respect to the step of "receiving a signal for dragging said object with said distorted region from said initial position to a desired position for said object within said original image" as recited in Claim 1, the selection from Dursteler cited by the Examiner simply describes elements of a graphical user interface for adjusting a lens (i.e., a distorted region) that has been applied to an original image (e.g., the left hand images of the skull and the space shuttle). Dursteler does not teach or suggest the dragging of an object in the original image to which a lens has been applied as the Examiner suggests. The 'Move Lens' icon in Dursteler is for moving the lens to a new position in the original image while displaying the entire lens during movement. The 'Move Lens' icon of Dursteler cannot be used to move an object in the original image. This icon is fully described in the Applicant's United States Patent No. 7,197,719. As such, Dursteler does not teach or suggest that element of Claim 1 that recites: "receiving a signal for dragging said object with said distorted region from said initial position to a desired position for said object within said original image".

With respect to the step of "receiving a signal for dropping said object at said desired position" as recited in Claim 1, the selection from Dursteler cited by the Examiner does not teach or suggest the dropping of an object in the original image to which the lens has been applied as the Examiner suggests. The 'Place Lens' icon in Dursteler is for moving the lens to a new position in the original image while displaying just the perimeter of the lens during movement. The 'Place Lens' icon of Dursteler cannot be used to drop an object in the original image. Again, this icon is fully described in the Applicant's United States Patent No. 7,197,719. As such, Dursteler does not teach or suggest that element of Claim 1 that recites: "receiving a signal for dropping said object at said desired position".

With respect to that element of Claim 1 that recites “whereby said distorted region with said magnification facilitates accurate positioning of said object at said desired position”, Dursteler does not teach accurate positioning of an object in the original image. All Dursteler teaches is application of a lens to an original image or an object in the original image. As such, Dursteler does not teach or suggest that element of Claim 1 that recites: “whereby said distorted region with said magnification facilitates accurate positioning of said object at said desired position”.

Therefore, Dursteler does not teach or suggest those elements of Claim 1 that recite: “receiving a signal for dragging said object with said distorted region from said initial position to a desired position for said object within said original image”; “receiving a signal for dropping said object at said desired position”; and, “whereby said distorted region with said magnification facilitates accurate positioning of said object at said desired position”.

As such, and as Nelson has not been cited against the same elements of Claim 1 that Dursteler has been, the Examiner’s combination of Dursteler and Nelson does not teach or suggest the subject matter of Claim 1. Consequently, the Applicant respectfully submits that the Examiner has not established a prima facie case of obviousness against Claim 1 under 35 U.S.C. 103(a).

Fourth: On page 5 of the Office Action the Examiner states the following (underlining added):

“Notwithstanding several suggestions therein, Dursteler does not expressly teach that the method for positioning a selected object in an original image is done through the lens. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adjusted the distortion through a GUI overlay because Nelson et al. is directed toward the same field of endeavour of Dursteler: ‘display information within a confined display area’ (Nelson et al., para [0002]) so that one can ‘view, manipulate, and otherwise manage information’ (Nelson et al., para. [0002]).”

However, in the above selection, the Examiner does not state which element of Claim 1 is taught or suggested by Nelson. The limitation “the method for positioning a selected object in an original image is done through the lens” does not appear in Claim 1.

In addition, on page 16 of the Office Action the Examiner states (underlining added):

“Even though Dursteler does not expressly teach that the method for positioning a selected object in a original image is done through the lens, Nelson et al. teaches the claimed editing via direct manipulation.”

Again, the Examiner does not state which element of Claim 1 is taught or suggested by Nelson. The limitation “the method for positioning a selected object in an original image is done through the lens” does not appear in Claim 1.

As such, the Examiner’s combination of Dursteler and Nelson does not teach or suggest the subject matter of Claim 1. Consequently, the Applicant respectfully submits that the Examiner has not established a prima facie case of obviousness against Claim 1 under 35 U.S.C. 103(a).

Fifth: On pages 12-13 of the Office Action the Examiner provides arguments against the patentability of Claim 25. However, these arguments do not refer to the present wording of Claim 25. Rather, the Examiner’s arguments refer to the previous wording of Claim 25. As such, the Applicant respectfully submits that the Examiner has not established a prima facie case of obviousness against Claim 25 under 35 U.S.C. 103(a).

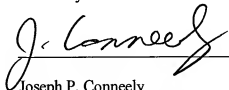
The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

McCarthy Tétrault LLP

Date: December 7, 2007

By



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